Remarks/Arguments

1. Introduction

Applicants note with appreciation the finding of allowable subject matter recited in claims 5, 8, 10, 11, and 13-20. Applicants choose, however, to proceed with prosecution of the remaining claims.

2. Information Disclosure Statement

a. *IDS filed January 18, 2005*

In the Office action, it was stated that in an Information Disclosure Statement [hereinafter IDS1] filed on January 14, 2005 and received by the United States Patent and Trademark Office [hereinafter USPTO] on January 18, 2005, references B437 and B467 were not provided. To that end, Applicants acknowledge references B437 and B467 were not provided with IDS1. Upon closer review, it is determined that reference B437 and B467 are not relevant to the present application.

b. *IDS filed March 31, 2005*

In the Office action, it was stated that in an Information Disclosure Statement [hereinafter IDS2] filed on March 29, 2005 and received by the USPTO on March 31, 2005, United States patent applications having reference numbers C18 and C24-C29 should be listed under other prior art. To that end, Applicants submit herewith an Information Disclosure Statement [hereinafter IDS3] having the aforementioned United States patent application correctly listed. More specifically, references C18 and C24 of IDS2 are cited as references D6 and D8 of IDS3 respectively, now United States patent application Publications; and references C25-C29 of IDS2 are cited as references D12-D16 of IDS3 respectively.

3. Amendments to the Specification

To have a more definite and clearly defined invention, Applicants has amended paragraphs [0035] and [0041] of the written specification. Also, Applicants have amended paragraph [0024] of the written specification to be commensurate with the claims. More specifically, the present application incorporates by reference United States patent application number 10/463,396. See paragraph [0025]. As a result, United States patent application number 10/463,396 is deemed to be recited in the present application. See MPEP section 2163.07(b). To that end, the subject matter amended into paragraph [0024] is recited in paragraph [0027] of United States patent application number 10/463,396. No new subject matter has been introduced by these amendments.

4. Claim Objections

In the Office action, claims 3 and 12 were objected to under 37 CFR 1.75(c) as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. More specifically, it was stated that the term "material" lacked antecedent basis. To that end, Applicants have amended claims 1 and 10 from which claims 3 and 12 dependent from, respectively, such that claims 3 and 12 comport with the requirements set forth in 37 CFR 1.75(c). No new matter has been introduced by these amendments.

5. Rejections under 35 § 102(b)

In the Office Action, claim 1 was rejected pursuant to 35 USC section 102(b) as allegedly being anticipated by United States patent 5,477,058 to Sato [hereinafter referred to as Sato]. To summarize the standard, rejections under section 102 are

proper only when one prior art reference discloses every feature of the claimed invention so that there is no physical difference between the reference and the claimed invention. See *In re Marshall*, 198 USPQ 344 (CCPA 1978). In addition, inchoate in any rejection pursuant to 35 USC section 102 is an obviousness rejection pursuant to 35 USC section 103. As a result, Applicants address any inchoate obviousness rejections along with the rejections under 35 USC section 102.

Claim 1, as amended, defines a template having alignment marks formed thereon, the template including, *inter alia*, a body having a patterning area, with the alignment marks being positioned on a region of the template outside of the patterning area and further being surrounded by a moat, with the alignment marks comprising a material opaque to a first wavelength of light.

Applicants advocate this template to prevent a curable liquid positioned upon a substrate from being in superimposition with the alignment marks of a template during imprinting of the curable liquid. See paragraph [0007]. More specifically, Applicants' claimed invention involves surrounding the alignment marks with a moat system having a sufficient depth to prevent a curable liquid from egressing therein due to capillary forces. See paragraph [0041].

Sato is completely silent with respect to surrounding alignment marks formed on a template with a moat. Rather Sato is merely directed at forming alignment marks of a differing material from a material that features of the template are formed from. More specifically, Sato teaches the features of the template are formed from a "single layer material

[hereinafter referred to as material A] performing the dual function of attenuating and phase shifting the light transmitted therethrough." See column 4, lines 1-4. However, Sato teaches the alignment marks "cannot be properly detected by the alignment equipment" if comprised of material A. See column 4, lines 37-38. To that end, the alignment marks were formed from "a layer of material which is substantially opaque to visible light." See column 4, lines 53-55. Furthermore, Sato teaches forming the alignment marks on the kerf of the template. See column 3, lines 55-56. To that end, the kerf of the template is defined by Sato as simply the periphery of the mask outside of the pattern area. See column 1, lines 55-56. However, Sato has no mention of surrounding the alignment marks formed on the kerf of the template with a moat, as described by Applicants' claimed invention. As a result, Sato does not direct his invention to surrounding alignment marks formed on a template with a moat.

Furthermore, as a result of Sato being completely silent with respect to surrounding alignment marks formed on a template with a moat, Sato does not recognize Applicants' problem and, therefore, there is no suggestion to modify Sato to include Applicants' claimed method. See *In re Sponnoble*, 160 USPQ 237 (CCPA 1969) (finding that is well established that an invention having an otherwise obvious structure is subject to patent protection if it overcomes a know problem, the source of which the art had not previously recognized), see also, *In re Nomiya*, 184 USPQ 607, 612 (CCPA 1975) (holding that where the prior art fails to recognize the problem at all, the claimed invention may be deemed patentable).

Based upon the forgoing, Applicants respectfully contend that Sato does not anticipate the invention defined by claim 1, as amended, and a *prima facie* case of obviousness is not present with respect to claim 1, as amended.

6. The Non-obviousness of the Dependent Claims

Considering that the dependent claims include all of the features of the independent claims from which they depend, these claims are patentable to the extent that the independent claims are patentable. Therefore, Applicants respectfully contend that the dependent claims define a system suitable for patent protection.

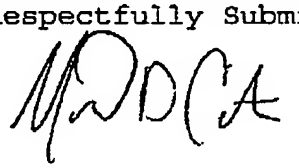
Applicants respectfully request examination in view of the remarks. A notice of allowance is earnestly solicited.

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents.

Signed: Katrina Prati
Typed Name: Katrina Prati
Date: 7-21-05

Respectfully Submitted,



Michael D. Carter
Reg. No. 56,661
Registered Patent Agent
Legal Department
Molecular Imprints, Inc.
P.O. Box 81536
Austin, Texas 78708-1536
Telephone: 512-339-7760
Facsimile: 512-491-8918